

REMARKS

Claims 2-4, 6-8, 10, 11, 13-18, 21-28 and 30-37 are pending in the instant application and stand rejected. Claims 2, 3, 11, 21 and 30 have been amended, and new Claims 38-39 are submitted for consideration by the Examiner.

Applicants respectfully request reconsideration and allowance of the pending claims.

Applicants respectfully submit that the objections to Claim 4 and 11 have been overcome by the Amendment. Applicants respectfully request withdrawal of these objections.

The rejection of Claims 2-4, 6-8, 10, 13-15, 21-24, 26-28 and 30-37 under 35 USC 103(a) as being unpatentable over Wiercinski et al (U.S.P.N. 4,600,635) in view of Heimann et al. (USPN 6,017,857), is respectfully traversed.

Wiercinski relates to bitumen waterproofing membranes for roofs. Heimann relates to lubricants, greases or gels having desirable corrosion resistant properties. In contrast to Heimann, Wiercinski teaches that relatively high levels of oils is undesirable (i.e., refer to Col. 2, Lines 12-19 of Wiercinski). A skilled person in this art would lack the requisite motivation to combine Wiercinski and Heimann because Heimann employs an amount of oil that Wiercinski indicates is undesirable. Further Wiercinski lacks any indication that corrosion resistance is a problem or that an increase in pH would be desirable. For these reasons, a skilled person in this art would not combine these references and accordingly, these references cannot establish a prima facie case of obviousness.

The rejection of Claim 11 under 35 U.S.C. 103(a) as being unpatentable over Wiercinski et al., Heimann et al., and Vogel et al (U.S.P.N. 6,528,174), is respectfully traversed.

Wiercinski and Heimann contain the aforementioned deficiencies. These deficiencies are not overcome by Vogel. Vogel relates to EVA films and has no disclosure relating to roofing membranes or corrosion resistant lubricants, greases and gels. It is respectfully submitted that in the absence of Applicants' disclosure there would be no motivation to combine these three references. Accordingly, there is insufficient motivation to combine these references and, if combined, these references fail to establish a prima facie case of obviousness.

The rejection of Claim 16 under 35 U.S.C. 103(a) as being unpatentable over Wiercinski et al., Heimann et al., and Glorieux (U.S.P.N. 5,399,189), is respectfully traversed.

Wiercinski and Heimann contain the aforementioned deficiencies. These deficiencies are not overcome by Glorieux. Neither Wiercinski nor Heimann suggest the desirability of including an expansion agent in their respective products. Further, the disclosure of Glorieux lacks any disclosure that expansion agents are desirable in Wiercinski's roofing membranes or Heimann greases. Applicants, therefore, respectfully submit that a skilled person in this art would consider these references as being non-analogous and not properly combined for establishing a *prima facie* case of obviousness.

The rejection of Claims 17 and 18 under 35 U.S.C. 103(a) as being unpatentable over Wiercinski et al., Heimann et al., and Karim et al. (U.S.P.N. 6,057,383), is respectfully traversed.

Wiercinski and Heimann contain the aforementioned deficiencies. These deficiencies are not remedied by Karim et al.

Wiercinski and Heimann include hydrocarbon polyolefin resins. Karim on Col. 2, Lines 36-48 expressly teaches away from compositions containing hydrocarbon polyolefin resins such as polyethylene, polypropylene and the like. Accordingly, it is respectfully submitted that a skilled person in this art would lack the requisite motivation to combine these conflicting references.

The rejection of Claim 25 under 35 U.S.C. 103(a) as being unpatentable over Wiercinski et al., Heimann et al., and Weidenbenner et al. (U.S.P.N. 3,908,064), is respectfully traversed.

Wiercinski and Heimann contain the aforementioned deficiencies. The Office Action indicates that a completely cured, tough and hard material is desirable. However, neither Wiercinski nor Heimann indicate any desirability for a complete cure. Indeed a completely cured, tough and hard material is incompatible with the operation of the lubricants and greases disclosed by Heimann. Consequently, a skilled person in this art would lack the requisite motivation to combine Wiercinski, Heimann and Weidenbenner.

This Application is also related to continuing patent application Serial No. 10/375,555 filed on February 26, 2003 (confirmation no 9127). Applicants respectfully request consideration of this patent application as well as the references cited therein.

Applicants believe that the pending claims define patentable subject matter and respectfully request issuance of a Notice of Allowability. Please find attached hereto a Petition For A One-Month Extension Of Time. Should there be any other fee due in connection with this application, please charge the same to Deposit Account No. 15-0680 (ORSCHELN MANAGEMENT CO.). Should the

Examiner deem that any further action on the part of Applicants would advance prosecution, the Examiner is invited to telephone Applicants' attorney.

Respectfully Submitted,



Michael K. Boyer
Attorney for Applicants
U.S.P.T.O. Reg. No. 33,085
Tel: 660 269-4536
Fax: 660 269-4530
mboyer@orscheln.com

Encl.: Petition For a One-Month Extension Of Time
Certificate of Facsimile Transmission Dated: August 02, 2004